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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/473,360

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SOON-JIN KIM

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9893

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06/03/2005

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EXAMINER

NGUYEN, TU X

ART UNIT

PAPER NUMBER

2684

DATE MAILED: 06/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/473,360

**Applicant(s)**

KIM, SOON-JIN

**Examiner**

Tu X Nguyen

**Art Unit**

2684

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's arguments filed 4/18/05, have been fully considered but they are not persuasive.

Applicant argue that "However, in response to the arguments filed on October 13, 2004, the Examiner now asserts that Jonsson teaches several exemplary apparatus for communicating input symbols over a speech channel", only one of which teaches using the formant frequencies. To allegedly evidence this teaching, the Examiner again cites col. 10, lines 39-44 of Jonsson, which reads as follows: in still another exemplary application, the user may send short messages or commands to the server both during voice conversation and when no communication is going on". The examiner agrees with applicants' argument, Johnsson et al. disclose "the user may send short messages or commands to the server both during voice conversation and when no communication is going" reads on claim limitation "transmitting a character message while maintaining a conversation".

Applicants argue that "More specifically, it appears the Examiner is attempting to argue that Jonsson teaches when no conversation is taking place, no conversion would be performed on the character data before transmission. However, as recited in the independent claims of the present application, non-converted character data is being transmitted during a conversation. This feature is not taught in this cited section or any other section of Jonsson. That is, there is no section of Jonsson that teaches transmitting non-converted character data during a conversation". However, it is not

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clear or how to interpret, other than "SMS message" in applicant specification page 7 first paragraph, the "none-converted character data" is not in the specification and how to elaborate "none-converted character data".

Applicants argue that "Jonsson provides no teachings of how character data is transmitted when no conversation taking place". In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "character data is transmitted when no conversation taking place") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -  
(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. Claims 1-2 are rejected under 35 U.S.C. 102(e) as being anticipated by Jonsson et al. (US Patent 6,385,585).

As to claim 1, Jonsson et al. disclose a method for transmitting a character message in a mobile communication terminal while maintaining a conversation by

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telephone (see col.10 lines 32-39), the examiner interprets "during an ongoing conversation" reads on "while maintaining conversation", comprising the steps of:

Setting the mobile communication terminal to a character message-transmitting/receiving mode while in a state in which a speech path has been established between the mobile communication terminal and a mobile communication terminal of a party other than the user (see col.3 lines 46-67); and

inputting a character message while in the character message-transmitting/receive mode, processing the written character message and transmitting the written character message including non-converted character data to the communication terminal of the other party via the established speech path in the character message-transmitting/receiving mode (see col.10 lines 39-44, a short message corresponds to "non-converted character data").

As to claim 2, Jonsson et al. disclose returning the mobile communication terminal of the user to a phone mode after the transmission of the character message to the mobile communication terminal of the other party (see col.11 lines 39-44).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jonsson et al. and further in view of Makela et al. (US Patent 6,301,338).

As to claim 3, Jonsson et al. fail to disclose the character message input during the character message-transmitting/receiving mode is selected among character messages previously written and stored in a registered state.

Makela et al. disclose the character message input during the character message-transmitting/receiving mode is selected among character messages previously written and stored in a registered state (see col.5 lines 44-51). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Jonsson et al. with the above teaching of Makela et al. in order to provide user conveniently to transmit pre-stored messages to other party.

6. Claims 4-5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jonsson et al. and further in view of Svensson (US Patent 5,687,216).

As to claim 4, Jonsson et al. fail to disclose receiving a character message from the mobile communication terminal of the other party, the mobile communication terminal displaying the received character message.

Svensson discloses receiving a character message from the mobile communication terminal of the other party, the mobile communication terminal displaying the received character message (see col.6 lines 8-9). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Jonsson et al. with the above teaching of Svensson in order to provide

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another message is received before the users reads the current message (as suggested by Svensson, see col.6 lines 1-7).

As to claim 5, the modified Jonsson et al. disclose all limitations as to claims 1 and 4 above.

### **Conclusion**

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tu Nguyen whose telephone number is 571-272-7883. The examiner can normally be reached on Monday through Friday from 8:30AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MAUNG NAY A, can be reached at (571) 272-7882. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

TN

May 26, 2005

  
NAY MAUNG

SUPERVISORY PATENT EXAMINER